

PU3761US2

Appl. No. 09/725,652

Remarks

Claims 1-54 are pending in this application. The Examiner has rejected claims 1-6, 11-23, 28-41 and 46-54 under 35 U.S.C. 102 (e) as being anticipated by *Haugland et al.* (USPN 6,399,392). According to the Examiner, *Haugland* teaches all of the elements of the rejected claims and specifically discloses, "a polymeric acid primer-template complex labeled with an energy-emitting chemical species and a nucleotide labeled with an energy-emitting chemical species."

A claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found in the reference. Applicants include in their claims the limitation of "a polymeric acid primer-template complex labeled with an energy-emitting chemical species and a nucleotide labeled with an energy-emitting chemical species." The specification defines "energy-emitting species" as "an atom, molecule, complex or other chemical species that emits energy in response to a stimulus," and further that the energy-emitting chemical species are useful "so long as the emitted energy from one chemical species is sufficiently intense so as to produce as an energy emission from the other chemical species in accordance with the present invention." (Page 9 lines 1-6). The claimed use of two energy emitting chemical species is not disclosed or suggested by the *Haugland* reference, rather, *Haugland et al.* teaches the use of a fluorescent oligonucleotide and a "quenching-compound labeled nucleotide." Given the language of the Applicants' claims and specification, *Haugland* does not teach or disclose "a polymeric acid primer-template complex labeled with an energy-emitting chemical species and a nucleotide labeled with an energy-emitting chemical species." Applicants respectfully submit that *Haugland et al.* does not anticipate the invention as set forth in claims 1-6, 11-23, 28-41 and 46-54 and request the rejection be withdrawn.

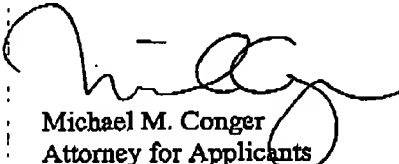
Under 35 U.S.C. 103 (a), the Examiner rejects claims 7-10, 24-27 and 42-45 as being unpatentable over *Haugland et al.* in view of *Bell et al.* (USPN 5,435,937); rejects claims 11, 12, 28, 29, 46, and 47 as being unpatentable over *Haugland et al.* in view of *Massey et al.* (USPN 5,770,459); rejects claims 33 and 51 as being unpatentable over *Haugland et al.* in view of *Cunningham et al.* (USPN 5,534,617); and rejects claims 34 and 52 as being unpatentable over *Haugland et al.* in view of *Hill et al.* (USPN 5,736,195). The Examiner argues that the rejected claims are obvious in light of the combined references. As discussed above, *Haugland* alone

PU3761US2
Appl. No. 09/725,652

does not teach the energy emitting species of the claimed invention. Similarly, *Haugland* in combination with *Bell* or in combination with *Massey*, or in combination with *Cunningham* or in combination with *Hill* does not render the claims obvious as none of the references alone or in combination teach, disclose, or suggest the invention as claimed, namely, "a polymeric acid primer-template complex labeled with an energy-emitting chemical species and a nucleotide labeled with an energy-emitting chemical species." Applicants request the rejection be withdrawn and the pending claims be given favorable reconsideration.

Applicants believe that no fees are due in connection with the filing of this paper other than those specifically authorized herewith. However, should any other fees be deemed necessary to effect the timely filing of this paper the Commissioner is hereby authorized to charge such fees to Deposit Account No. 07-1392.

Respectfully submitted,



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